

SEP 10 1999



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Ms. Amy E. Mandragouras
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In re Application of :
BALMAIN et al : DECISION ON
Application No.: 09/051,159 :
PCT No.: PCT/GB96/02416 : PETITION
Int. Filing Date: 02 October 1996 :
Priority Date: 02 October 1995 : UNDER 37 CFR 1.47(a)
Attorney's Docket No.: CCI-005US :
For: ANTITUMOUR VECTOR CONSTRUCTS AND :
METHODS :

This decision is in response to applicants' "Petition Pursuant to 37 C.F.R. §1.47(a)" filed 13 January 1999 requesting acceptance of the application without the signature of one of the joint inventors, i.e., Dr. Zhu. The petition fee has been paid.

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

BACKGROUND

On 02 October 1996, applicants filed international application PCT/GB96/02416, which designates the U.S. and claims a priority date of 02 October 1995. A Demand electing the U.S. was filed within 19 months from the priority date. Accordingly, the 30-month period for entry into the U.S. national stage expired at midnight on 02 April 1998.

On 02 April 1998, applicants filed in the United States Designated/Elected Office (DO/EO) a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite U.S. basic national fee and an unexecuted declaration.

On 13 July 1998, the United States DO/EO mailed to applicants a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and a surcharge for the late submission thereof.

On 13 January 1999, applicants filed the present petition under 37 CFR 1.47(a) requesting acceptance of the application without the signature of one of the joint inventors, i.e.,

Dr. Zhu. The petition is accompanied by, *inter alia*: 1) an "Affidavit by Anne Zwirlein and Margaret Roberts in Support of Petition Pursuant to 37 CFR 1.47(a)"; 2) a declaration executed by the other joint inventor, i.e., Mr. Balmain; 3) payment/request for a 5-month extension of time; and 4) a surcharge fee for the late submission of the declaration.

DISCUSSION

A petition pursuant to 37 CFR 1.47(a) to accept the application without the signature of one of the joint inventors must include: 1) an oath or declaration signed by all available joint inventors on their own behalf and on behalf of the nonsigning inventor; 2) proof that the nonsigning inventor refuses to join in an application for patent or cannot be found or reached after diligent effort; 3) the petition fee; and 4) the last known address of the nonsigning inventor.

Petitioners have satisfied items (1), (3) and (4).

With regard to item (2), the petition does not include sufficient proof that the nonsigning inventor either refuses to sign or cannot be found or reached after diligent effort. The proffered evidence consists of an affidavit by Anne Zwirlein and Margaret Roberts offered to establish that inventor Zhu refuses to execute the present application. However, the affidavit does not specifically identify the present application. Accordingly, it is not clear whether Dr. Zhu's refusal relates to the present application, or possibly a different one. In addition, in paragraph (5), the statement attributed to Dr. Zhu is enclosed by only a single quotation mark. Accordingly, it is not clear what has been stated by Dr. Zhu. Moreover, it appears that Dr. Zhu is denying inventorship, as he states that "it had nothing to do with him." Is this correct?

Paragraph (4) references attached letters sent to Dr. Zhu in the period *after* 18 August 1998 until October 1998. Yet no letters have been attached. An August 18, 1998 letter is attached, however this letter is not referred to in the affidavit. Is this related to the 18 August 1998 communication referenced in paragraph (3)? It is noted that paragraph (3) indicates that a copy of the application was sent with a declaration, power of attorney and assignment documents, yet the 18 August 1998 letter does not mention an enclosed application but does mention the other documents. Further, facts relating to the mailing of these letters are missing, e.g., how were these letters mailed, do petitioners have any receipts from a courier, etc.? Attention is directed to MPEP 409.03(d), which provides in part:

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

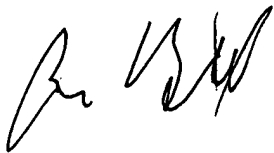
For the above reasons, it would not be appropriate to grant the petition under 37 CFR 1.47(a) at this time.

DECISION


The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to provide either a declaration in compliance with 37 CFR 1.63 or a petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the PCT Legal Office.



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